

ARGUMENTS/REMARKS

Applicants would like to thank the examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action, and amended as necessary to more clearly and particularly describe and claim the subject matter which applicants regard as the invention.

Claims 1-32, and 34-40 remain in this application. Claim 33 has been canceled. Claim 41 has been added.

Claims 1-4, 10-15, and 29-40 were rejected under 35 U.S.C. §102(e) as being anticipated by Fraccaroli (U.S. Pat. App. 2004/0002348). Claims 5-9 and 16-28 were rejected under 35 U.S.C. §103(a) as being unpatentable over Fraccaroli in view of various other cited references. For the following reasons, the rejections are respectfully traversed.

Claim 1, as amended, recites the step of "sending a message to at least one of said members if he is in the vicinity of another of said members of the common interest group" wherein "said message comprises physical identification characteristics that enable the personal recognition of the another of said members by the one of said members." Claim 40 recites similar limitations.

Fraccaroli does not suggest sending a message comprising "physical identification characteristics" enabling "the personal recognition" of one of the members, as recited in the claims. Accordingly, claims 1 and 40 are patentable over the reference. Claims 2-4, 10-15, and 29-39, which depend on claim 1, are thus patentable over the reference for at least the same reason as the parent claim.

The other cited references do not overcome the shortcomings of the Fraccaroli reference. Accordingly, claims 5-9 and 16-28 are patentable over the combination of references.

Furthermore, the Examiner has not provided the proper motivation for combining the references. The burden is on the Examiner to make a prima facie

case of obviousness (MPEP §2142). To support a prima facie case of obviousness, the Examiner must show that there is some *suggestion* or *motivation* to modify the reference (MPEP §2143.01). The mere fact that references *can* be combined or modified, alone, is not sufficient to establish prima facie obviousness (*Id.*). The prior art must also suggest the *desirability* of the combination (*Id.*). The fact that the claimed invention is within the *capabilities* of one of ordinary skill in the art is not sufficient, by itself, to establish prima facie obviousness (*Id.*).

Instead, the Examiner has merely listed a generalized benefit of the secondary reference, and has improperly attempted to use that benefit as motivation for modifying Fraccaroli. Merely listing an advantage or benefit of the combination is not sufficient, as some rationale for combining the references must be found in the references themselves, or drawn from a convincing line of reasoning based on established scientific principles practiced by one skilled in the art that some advantage or beneficial result would be produced by the combination (MPEP §2144). Such motivation cannot be found in the application itself, as such hindsight is impermissible; the facts must be gleaned from the prior art. (MPEP §2142, last paragraph).

"To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made [and] the examiner must then make a determination whether the claimed invention 'as a whole' would have been obvious at that time to that person." (MPEP §2142, emphasis added). It is not proper to merely combine various elements from various references. The invention must be obvious "as a whole", not as a piecemeal combination of elements from various references.

Accordingly, the rejections for obviousness are not supported by the Office action and thus the rejection is improper, and should be withdrawn.

Finally, new claim 41 recites the step of "billing a party for said sending of said message". The Examiner has cited a reference for teaching billing for a registration,

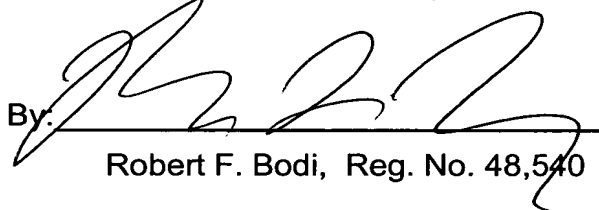
but none of the cited references suggest billing for the sending of the message of the claim. Accordingly, claim 41 is patentable over the references.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 33835.

Respectfully submitted,

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